

**THIS DISPOSITION  
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Mailed: September 6, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re YHWH Our Righteousness Corporation

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Serial No. 76477230

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Brian M. Mattson, Esq. for YHWH Our Righteousness Corporation.

William H. Dawe III, Trademark Examining Attorney, Law Office 108 (Andrew Lawrence, Managing Attorney).

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Before Walters, Drost and Zervas, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

YHWH Our Righteousness Corporation has filed an application to register on the Principal Register the standard character mark YHWH OUR RIGHTEOUSNESS for "educational services, namely, conducting classes and workshops in the field of the Book Of Remembrance or Old Testament," in International Class 41.<sup>1</sup> Following a

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<sup>1</sup> Serial No. 76477230, filed December 16, 2002, based on an allegation of a bona fide intention to use the mark in commerce. Following publication of the mark for opposition and issuance of a notice of

requirement by the examining attorney for a disclaimer of RIGHTEOUSNESS, applicant submitted a disclaimer of RIGHTEOUSNESS and ILLINOIS apart from the mark as a whole, although we note that the term ILLINOIS is not part of the applied-for mark.<sup>2</sup>

The examining attorney has issued a final refusal to register, citing 37 CFR 2.56(b)(2), on the ground that applicant has not complied with the requirement to submit a specimen of record that shows use of the mark in connection with the identified services.

Applicant has appealed. Both applicant and the examining attorney have filed briefs.

With its statement of use applicant submitted a brochure as its specimen of use. On one side, the brochure shows, *inter alia*, the mark as part of a circular blue emblem. The written matter below the emblem states "for more information contact: YHWH OUR RIGHTEOUSNESS" with a Chicago address. The written matter in the lower right-hand corner of one page states: "FOR YHWH OUR RIGHTEOUSNESS, FOR YERUSELUM AND THE HOLY SEED." On the other side, there are two full pages of text that include use of the term YHWH OUR RIGHTEOUSNESS and describe YHWH OUR RIGHTEOUSNESS as a tax-exempt movement. The remainder of the text on all pages of

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allowance, applicant filed a statement of use, alleging first use and use in commerce as of July 21, 2004, and a specimen of use.

the brochure contains quotes from religious texts and comments about and interpretations of those quotes.

In the November 1, 2005, final refusal, the examining attorney concluded that this specimen is unacceptable for the following reasons:

The current specimen comprises a brochure with various religious passages or quotes and is unacceptable as evidence of actual service mark use because it does not show proper use of the mark with the identified educational services. Put another way, applicant's current specimen does not reflect that the applicant is offering educational services. The applicant presents arguments that the specimen shows use of the mark with actual educational services, not as an advertisement for educational services. This argument is without merit because the applicant's specimen clearly states "FOR MORE INFORMATION CONTACT: YHWH OUR RIGHTEOUSNESS."

In its request for reconsideration, applicant submitted a substitute specimen, with the appropriate declaration of use. The substitute specimen is in the form of a five-page open letter. The letterhead on the first page contains the term YHWH OUR RIGHTEOUSNESS at the top, with the phrase "a non-profit organization" directly below it. The body of the letter consists of a discussion of religious texts and, as with the brochure, contains comments about and interpretations of religious principles. The first paragraph of the letter is reproduced below:

It is very important that you thoroughly read and examine this letter as well as the enclosed flyer.

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<sup>2</sup> Should applicant ultimately prevail in this appeal, the disclaimer of ILLINOIS will be deleted from the record.

Take your time and read carefully using the Book of Remembrance, the so-called Old Testament (Mal 3:16), because it contains a lot of very important information which YHWH OUR RIGHTEOUSNESS sends you to keep your mind and spirit out of darkness (Jer. 23 and Jer. 33). Please feel free to share this letter and information with relatives and friends.

The examining attorney summarily denied the request for reconsideration, without reference to the substitute specimen.

Applicant, in its brief, addresses its argument to only the original specimen of use. The examining attorney, in his brief, addresses his argument to both specimens of use, but focuses on the first one filed. Therefore, we will consider the second submission to be an additional, rather than a substitute, specimen of use and determine whether either or both are acceptable to show use of the mark in connection with the identified educational services.

In its brief, applicant contends that the examining attorney has failed to provide evidence that educational services cannot be offered in the field of the Book of Remembrance or Old Testament, or that a presentation targeted to and organized around particular religious passages does not constitute educational services, or that consumers would believe the specimen was associated with religious services instead of the identified educational services. Applicant states that the specimen shows use of the mark in the course of actually performing the services,

which constitutes an acceptable specimen of service mark usage. Applicant makes the following statement about the nature of its services:

The present mark is used for educational services that are provided without cost, as a ministry to potential purchasers. [Applicant] conducts free workshops and classes via mailings to potential purchasers, many of whom are incarcerated inmates.

Section 1 of The Trademark Act requires that an applicant submit "specimens or facsimiles of the mark as used in commerce." 15 U.S.C. § 1051. Trademark Act Section 45 provides further that a mark is "in use in commerce ... on services when it is used or displayed in the sale or advertising of the services." 15 U.S.C. § 1127. The Trademark Rules likewise specify, "a service mark specimen must show the mark as actually used in the sale or advertising of the services." 37 C.F.R. § 2.56(b)(2). Trademark Act Section 45 also sets forth the fundamental definition of a service mark as a mark used "to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown." 15 U.S.C. § 1127. This definition is the basis for the requirement that the mark, as used in the specimen, must "function" as a service mark. Our primary reviewing court has held that a service is "the performance of labor for the

benefit of another." *See In re Canadian Pacific Ltd.*, 754 F.2d 992, 224 USPQ 971, 973 (Fed. Cir. 1985).

The recited services involved herein are clearly "services" under this definition, and we will presume that applicant in fact renders such services. However, the issue in this case is not whether applicant's activities constitute "services," or whether applicant in fact provides those services. Rather, the issue is whether the specimens of record demonstrate use of the mark as a service mark for those services.<sup>3</sup>

To be an acceptable specimen of use, there must be a direct association between the mark sought to be registered and the services specified in the application, and there must be sufficient reference to the services in the specimens to create this association. *See In re Monograms America Inc.*, 51 USPQ 1317 (TTAB 1999). The "direct association" test does not create an additional or more stringent requirement for registration; it is implicit in the statutory definition of "a mark used ... to identify and distinguish the services of one person ... from the services

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<sup>3</sup> The majority of the numerous cases cited by the examining attorney are inapposite because they address specimen issues different from the issue before us in this case. For example, the letter and brochure herein are not, per se, improper materials to show service mark use [*In re Johnson Controls, Inc.*, 33 USPQ2d 1318 (TTAB 1994), labels affixed to valve packaging do not show use of mark for custom manufacturing services], nor is there any question as to whether the applied-for mark functions as a mark because of its size and manner of presentation in the brochure or letter [*In re Signal Companies, Inc.*, 228 USPQ 956 (TTAB 1986), applied-for mark is merely informational slogan appearing in small lettering beneath the address of applicant's subsidiary].

of others and to indicate the source of the services." *In re Advertising & Marketing Development Inc.*, 821 F.2d 614, 2 USPQ2d 2010, 2014 (Fed. Cir. 1987) (footnotes omitted).

The determination of whether applicant's specimens show the mark YHWH OUR RIGHTEOUSNESS in connection with the sale or advertising of the identified educational services necessarily requires a consideration of the specimens, which are described above. As noted above, Trademark Rule 2.56(b)(2) provides that "[a] service mark specimen must show the mark as actually used in the sale or advertising of the services." In this case, applicant's specimens clearly are not advertisements for the recited services because they do not show the requisite direct association between the mark and the recited services. See *In re Adair*, 45 USPQ2d 1211 (TTAB 1997); and *In re Johnson Controls, Inc.*, 33 USPQ2d 1318 (TTAB 1994). The original specimen, the brochure, is an advertisement for applicant's religious creed, not an advertisement for the recited educational services; indeed, the brochure contains no reference to classes or workshops. Likewise, the letter submitted as an additional specimen is not an advertisement for the recited services, because it makes no reference to the services per se.

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However, applicant contends that even if the specimens do not show use of the mark in the advertising of the services (because they make no direct reference to the services), they nonetheless are adequate service mark specimens because they show the mark as it is used in the course of the actual rendering of the recited educational services. Applicant is correct that, where the specimens show use of the mark in the rendering (as opposed to the advertising) of the services, a reference to the services on the specimens themselves may not be necessary. *In re Metriplex Inc.*, 23 USPQ2d 1315 (TTAB 1992); *In re Eagle Fence Rentals, Inc.*, 231 USPQ 228 (TTAB 1986); and *In re Red Robin Enterprises, Inc.*, 222 USPQ 911 (TTAB 1984).

It would appear to be applicant's contention that its services are rendered through the content of its letter and brochure. We are not persuaded by this argument. The Board rejected a similar argument in the case of *In re Landmark Communications, Inc.*, 204 USPQ 692 (TTAB 1979). In that case, the applicant sought to register the mark THE DAILY BREAK as a service mark for "educational and entertainment services comprising the collection, printing, presentation and distribution of a newspaper section of cultural and leisure information" on various topics. The specimen of use submitted by the applicant was a copy of the newspaper section which bore the mark as its title, as published in



the applicant's newspaper. The Board rejected the applicant's contention that, in publishing the newspaper section, it was performing or rendering the recited services, or any service. "Applicant sells goods, not services for every individual reader." 204 USPQ at 696.

Similarly in this case, in printing and distributing its brochure and letter, the purchaser is not receiving educational services in the nature of classes and workshops from applicant, but rather is receiving an informational tract created by applicant, i.e., a product. Just as a newspaper publisher is not rendering educational or informational services merely by publishing a newspaper section with educational content, applicant herein is not rendering educational services merely by printing a brochure and letter about its religious creed. In the above-cited cases of *In re Metriplex*, *In re Eagle Fence*, and *In re Red Robin*, the specimens were deemed acceptable because they showed how the respective marks were being used in connection with the recited services as the services were being performed, i.e., during the transmission of data via computer in *Metriplex*, during the rental of fencing in *Eagle Fence*, and during the performance of entertainment services in *Red Robin*. In the present case, by contrast, any activity or labor performed by applicant in producing and distributing its brochure and letter has already concluded

by the time these documents are received; the recipient is not buying an ongoing provision of services by applicant, but rather is simply invited to contact applicant for more information about applicant's religious creed. Again, the issue here is not whether applicant is in fact rendering the educational services in the form of classes and workshops recited in the application, but rather whether the specimens of record demonstrate service mark use of the mark in connection with such services. For the reasons discussed above, we find that they do not.

*Decision:* The refusal to register on the ground that the specimens of record are unacceptable is affirmed.